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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86803643
Applicant	Cardinal Logistics Management Corporatio
Applied for Mark	CARDINAL DEDICATED DELIVERY LOGISTICS
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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

Applicant: Cardinal Logistics Management Corporation

Serial No. 86803643

Filed: October 29, 2015

Mark: CARDINAL DEDICATED / DELIVERY / LOGISTICS



APPLICANT'S APPEAL BRIEF

INTRODUCTION

Pursuant to the Notice of Appeal filed on September 15, 2016, the Applicant hereby appeals from the Examining Attorney's final refusal to register the above-identified mark, dated May 11, 2016, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision on the grounds that the Applicant's mark does not create a likelihood of confusion with the reference cited by the Examining Attorney.

STATEMENT OF FACTS

Applicant seeks registration of its mark in association with “supply chain management services; arranging for pickup, delivery, storage and transportation of freight via ground carriers; transportation logistic services, namely, arranging the transportation of goods for others; transportation and logistics services, namely, planning and scheduling shipments for users of transportation services; freight logistics management; transportation logistics services, namely, arranging the transportation of goods for others; transportation logistics services, namely, planning and scheduling shipments for users of transportation services; transportation management services, namely, planning and coordinating transportation of freight for others; inventory control; inventory management; business management consulting in the field of transportation logistics; business advisory services in the field of transportation logistics; business consulting services relating to product distribution, operations management services, logistics, reverse logistics, supply chain, and production systems and distribution solutions; Business management services, namely, managing logistics, reverse logistics, supply chain services, supply chain visibility and synchronization, supply and demand forecasting and product distribution processes for others,” in Class 35; and “delivery of goods; Supply chain logistics and reverse logistics services, namely, transportation and delivery of goods for others by truck; Supply chain logistics and reverse logistics services, namely, transportation and delivery of documents, packages, raw materials, and other freight for others by truck; transportation consulting; transportation information; transportation of goods; arranging for pickup, delivery, storage and transportation of freight via ground carriers; warehousing services; warehousing services, namely, storage, distribution, pick-up, and packing for shipment of documents,

packages, raw materials, and other freight for others,” in Class 39. The trademark application was filed on October 29, 2015 and was assigned Trademark Application Serial No. 86/803643.

The Examining Attorney initially refused registration of the present mark on the Principal Register contending that there was a likelihood of confusion between Applicant’s mark and United States Registration No. 3138897 for the mark CARDINAL in association with “railroad transportation services” in Class 39.¹ In addition, the Examiner required amendments to minor informalities. These informalities have been resolved. The likelihood of confusion refusal is the only issue remaining on appeal.

ISSUE

The sole issue on appeal is whether Applicant’s mark, CARDINAL DEDICATED / DELIVERY / LOGISTICS (as displayed below) is confusing similar to the Registrant’s mark.



Applicant’s mark is pending in association with the following services in Class 35 and Class 39:

“Supply chain management services; arranging for pickup, delivery, storage and transportation of freight via ground carriers; transportation logistic services, namely, arranging the transportation of goods for others; transportation and logistics services, namely, planning and scheduling shipments for users of transportation services; freight logistics management; transportation logistics services, namely, arranging the transportation of goods for others;

¹ February 25, 2016, Office Action

transportation logistics services, namely, planning and scheduling shipments for users of transportation services; transportation management services, namely, planning and coordinating transportation of freight for others; inventory control; inventory management; business management consulting in the field of transportation logistics; business advisory services in the field of transportation logistics; business consulting services relating to product distribution, operations management services, logistics, reverse logistics, supply chain, and production systems and distribution solutions; Business management services, namely, managing logistics, reverse logistics, supply chain services, supply chain visibility and synchronization, supply and demand forecasting and product distribution processes for others,” in Class 35.

“Supply chain logistics and reverse logistics services, namely, transportation and delivery of goods for others by truck; Supply chain logistics and reverse logistics services, namely, transportation and delivery of documents, packages, raw materials, and other freight for others by truck; transportation consulting; transportation information; transportation of goods; arranging for pickup, delivery, storage and transportation of freight via ground carriers; warehousing services; warehousing services, namely, storage, distribution, pick-up, and packing for shipment of documents, packages, raw materials, and other freight for others,” in Class 39.

Registrant’s mark is CARDINAL in association with “railroad transportation services,” in Class 39.

APPLICANT’S ARGUMENT

I. Considered in their Entireties, the Marks are Dissimilar in Appearance, Sound Connotation and Commercial Impression

Properly considered in their entirety, Applicant’s mark is dissimilar from the cited mark and confusion is unlikely. In determining whether marks are confusingly similar, the marks must be compared in their entirety for overall appearance, sound and commercial impression. In re

1776, Inc., 223 U.S.P.Q. 186, 187 (T.T.A.B. 1984). Properly considered in their entireties, Applicant's mark is dissimilar from the cited mark and confusion is unlikely. It is axiomatic that marks should not be dissected into segments when comparing them in a likelihood of confusion analysis. Id. at 187; In re Loew's Theatres, Inc., 218 U.S.P.Q. 956 (T.T.A.B. 1983).

Applying the first factor, appearance, Applicant's mark is CARDINAL DEDICATED / DELIVERY / LOGISTICS & Design. The cited mark is CARDINAL. There are vast differences between the marks due to the inclusion of the terms DEDICATED DELIVERY LOGISTICS in the Applicant's mark. The marks only share the term CARDINAL in common. DEDICATED DELIVERY LOGISTICS, and the Bird Design, differentiate the marks based on sound, appearance and meaning. These additional terms, and the design, distinguish the sources of the services.

The marks are differentiated by three entire words. DEDICATED, DELIVERY and LOGISTICS help to identify the source of the services. In a crowded field of CARDINAL trademarks, these words differentiate the Applicant's services from the Registrant's services. The Registrant, National Railroad Passenger Corp., deals with passenger transportation. The Applicant identifies its field of use as well. In Applicant's mark it expressly identifies delivery and logistics services. Applicant specializes in delivery of goods not passengers.

The mere similarity between the two marks should never be decisive of likelihood of confusion; especially when the only thing in common between the marks is a relatively common term, such as, CARDINAL. It is well settled that marks must be viewed in their entireties in analyzing likelihood of confusion, Franklin Mint Corp. v. Master Mfg. Co., 212 U.S.P.Q. 233, 234 (C.C.P.A. 1981). When Applicant's mark and the cited mark are viewed in their entireties, especially considering the terms DEDICATED / DELIVERY / LOGISTICS, it is respectfully

submitted that there is no likelihood of confusion between the marks. The design of the bird within the Applicant's mark helps to further distinguish the Applicant's mark from the Registrant's mark.

With respect to the sound of the marks, the words DEDICATED, DELIVERY and LOGISTICS greatly distinguish the marks phonetically. Passengers will call for Applicant's services by name, and will recognize these additional words in Applicant's mark. These differences in appearance and sound give the marks a different connotation and commercial impression. Indeed, rail passengers will not look for a mark that includes DELIVERY and LOGISTICS when they are considering transportation services. DELIVERY and LOGISTICS immediately identify the purpose of the services. People will not consider their own transportation as a "delivery" of themselves from one place to another. The meaning of Applicant's mark helps to avoid any likelihood of confusion. LOGISTICS helps to distinguish the marks in a similar fashion. LOGISTICS is intricately intertwined with the delivery of items, not passengers.

The Examiner largely dismisses the value of the terms DELIVERY and LOGISTICS in the marks because these terms are descriptive and disclaimed. "In the present case, the words 'cardinal' and 'dedicated' in applicant's mark creates the dominant commercial impression because 'delivery' and 'logistics' are descriptive of the services and have been disclaimed."² Applicant agrees that these terms are descriptive. However, the words have value associated with their ability to differentiate the marks. Moreover, the words reinforce the type and nature of the services that are distinguished from the Registrant's services.

² May 1, 2016 Office Action, TSDR p. 3

The Examiner not only denies that the image of the bird distinguishes the marks but argues that it reinforces confusion as to the term CARDINAL. “Applicant argues that the design of the bird in its mark distinguishes it from the registered mark. On the contrary, the design of the bird only reinforces the meaning of the word ‘cardinal’ which is a red bird.”³ Applicant does not deny that the image is of a red cardinal, but posits that the design still differentiates its mark from the remaining field of CARDINAL trademarks. The design is a distinguishing difference and is a vital part of the mark that is identified by the consumers and is recognized during the performance of the services.

Finally, under the Lanham Act, a refusal to register under likelihood of confusion requires that such confusion as the source of the services, must be not merely possible but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). In re Massey-Ferguson, Inc., 222 U.S.P.Q. 367 (T.T.A.B. 1983); Witco Chem. Corp. v. Whitfield Chem. Co., 164 U.S.P.Q. 43 (C.C.P.A. 1969).

II. The Services Differ Significantly

The Applicant’s services are “supply chain management services; arranging for pickup, delivery, storage and transportation of freight via ground carriers; transportation logistic services, namely, arranging the transportation of goods for others; transportation and logistics services, namely, planning and scheduling shipments for users of transportation services; freight logistics management; transportation logistics services, namely, arranging the transportation of goods for others; transportation logistics services, namely, planning and scheduling shipments for users of

³ May 1, 2016 Office Action, TSDR p. 3

transportation services; transportation management services, namely, planning and coordinating transportation of freight for others; inventory control; inventory management; business management consulting in the field of transportation logistics; business advisory services in the field of transportation logistics; business consulting services relating to product distribution, operations management services, logistics, reverse logistics, supply chain, and production systems and distribution solutions; Business management services, namely, managing logistics, reverse logistics, supply chain services, supply chain visibility and synchronization, supply and demand forecasting and product distribution processes for others,” in Class 35; and “Supply chain logistics and reverse logistics services, namely, transportation and delivery of goods for others by truck; Supply chain logistics and reverse logistics services, namely, transportation and delivery of documents, packages, raw materials, and other freight for others by truck; transportation consulting; transportation information; transportation of goods; arranging for pickup, delivery, storage and transportation of freight via ground carriers; warehousing services; warehousing services, namely, storage, distribution, pick-up, and packing for shipment of documents, packages, raw materials, and other freight for others,” in Class 39.

The Registrant, National Railroad Passenger Corporation, uses the mark in association with railroad transportation services. As the Registrant’s name indicates, the services are provided to “passengers”, not freight. Although both services are used in association with transportation there should be no presumption of confusion. The transportation services designate completely different fields; people, on the one hand, and the shipment of goods, on the other. Applicant’s “logistics” services are not generally used during transportation of people on rail. Passengers are delivered during well-defined transportation routes and on specific schedules.

III. The Trade Channels of the Applicant and the Registrant are Dissimilar

Registrant's services are in a different channel of trade when compared to Applicant's services. The Registrant provides passenger transportation. Applicant's services are dedicated to coordinating the shipment of goods. The registered mark resides in a trade channel where the targeted consumers are clearly distinguished. Because the channels of trade for the services offered by Applicant and Registrant are different, there is no likelihood of confusion. In re E. I. du Pont de Nemours, 177 U.S.P.Q. 563 (C.C.P.A. 1973); Electronic Data Systems, 23 U.S.P.Q.2d at 1460, 1462-63. Where the channels of distribution and/or advertising of the services are different, the likelihood of confusion between similar marks decreases. Id. at 1463. These differences among the services make the channels of distribution and advertising distinct, thereby avoiding any likelihood of confusion. Indeed, it is inconceivable that a consumer seeking freight management services would be confused by bucolic passenger transportation services.

IV. The Consumers to Whom Sales are Made are Sophisticated and Purchase the Services with Considerable Care and Thought

Given the cost associated with the services, purchasers of those services will not be impulse buyers that is, purchasers of applicant's services will be sophisticated consumers. See McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1137; 202 U.S.P.Q. 81, 92 (2d Cir. 1979). The price paid for the services is not a price which is paid without due consideration of the services being purchased. Indeed, it has been found that a reasonably prudent buyer will take more time and care in purchasing expensive items. Therefore, consumers will make a purchase after very careful consideration and will be more discriminating than the average purchaser. It is well settled that confusion is less likely where the goods "are relatively expensive items

purchased with a certain amount of care and thought, rather than inexpensive items purchased on impulse.” Information Res. Inc. v. X*Press Info. Serv., 6 U.S.P.Q.2d 1034, 1039 (T.T.A.B. 1988).

Applicant’s services sell for a significant price. Applicant offers supply chain management of freight and logistics services. Registrant offers passenger transportation services. The price paid for these services is not a price which is paid without due consideration of the service being purchased. The sophisticated nature of the consumers decreases the possibility of confusion dramatically.

It is inconceivable that these services will be purchased on impulse. Registrant provides passenger rail services.⁴ The Registrant, operating as Amtrak, identifies its CARDINAL services as follows on its website:

The Cardinal operates between New York and Chicago three days a week, offering unforgettable views of the Southeast's stunning natural beauty. You'll see gently rolling horse country, the Blue Ridge and Allegheny Mountains, the Shenandoah Valley, and the wild white-water rivers of West Virginia as they can only be seen by train. Heading westward, the train rolls along the banks of the mighty Ohio River — from the quaint towns of Ashland and Maysville, to the skyline of Cincinnati. From there, your journey continues to Indianapolis, and then northward to Chicago.

These are clearly defined passenger services. Applicant provides delivery and logistics services for goods. These logistics management services are not related to people or passengers. Logistics management services are expensive and highly technical in nature. Purchasers of the Registrant’s services will take the upmost care and exercise thought prior to purchasing the services. These services will not be purchased on impulse.

⁴ April 19, 2016, Response to Office Action, TSDR p. 7

Purchasers of the Registrant's services desire to travel between New York, Washington, Cincinnati, Indianapolis and Chicago. Applicant's services are marketed to companies that are managing their supply chain. The consumers are sophisticated. The services offered are mutually exclusive. The opportunity for confusion is non-existent.

V. A Significant Number of Similar Marks are Registered and in Use in Commerce

The word CARDINAL, is a relatively common term and a relatively common trademark. Purchasers have become accustomed to seeing the trademark CARDINAL in association with various goods and services. Consumers will therefore pay careful attention to the goods and services associated with each trademark. Indeed, Applicant itself is the Owner of three prior registrations of CARDINAL marks in association with freight transportation services. Please refer to Trademark Registration Number 4350697, for the mark CARDINAL HOSTED LOGISTICS; Trademark Registration 4402820, for the mark CARDINAL HOSTED LOGISTICS; and Trademark Registration 4563325, for the nearly identical CARDINAL DELIVERY LOGISTICS and Design.⁵

In the case of the present application, consumers can easily distinguish between a freight transportation management service and a passenger rail line named after a bird and its indigenous area. When viewed in the context of the number of similar marks including the word CARDINAL in association with transportation services, and when considering the differences in the nature of the services, as well as the overall appearance of the marks, it is respectfully submitted that analysis of the case under the Du Pont factors set forth in In re E. I. du Pont de

⁵ October 29, 2015, Trademark application filing, TSDR p. 1; April 19, 2016, Response to Office Action filing, TSDR p. 1

Nemours, 177 U.S.P.Q. 563 (C.C.P.A. 1973) does not warrant a finding of likelihood of confusion.

VI. The Nearly Identical Mark was Registered by the Trademark Office in Association with Identical Services

The pending trademark application is for the mark:



Applicant is the Owner of the following registration in association with identical services:



The Applicant has merely filed in color and switched the location of the bird. The Trademark Office registered a nearly identical mark in association with identical services.⁶ Although the trademark examiner is not bound by prior Examiner precedent it is respectfully submitted that the pending trademark application should be allowed for the sake of consistency. The prior trademark was not opposed or cancelled. There have been no adverse proceedings. There have been no reported instances of actual confusion in the marketplace. The registered marks have coexisted in the marketplace for approximately fifteen years.

CONCLUSION

Given the difference in the appearance of the marks, the differences in the nature of the services, the dissimilarity of trade channels, and the sophistication of those to whom sales are

⁶ Id.

made, it is respectfully submitted that there is no likelihood of confusion between Applicant's mark and the cited registration. When the common nature of CARDINAL marks is considered along with Applicant's prior registration of the nearly identical mark, it is evident that Applicant's mark is not confusingly similar to the cited mark and Applicant's mark is registrable. Applicant respectfully prays that the Board reverse the Examining Attorney's final refusal and allow Applicant's trademark application to be passed to publication and its mark to be registered on the Principal Register of the United States Patent & Trademark Office.

Alternative Position

Applicant believes that its trademark should be registered in the Principal Register as outlined above. If the Trademark Trial and Appeal Board disagrees but will allow for registration of the trademark in association with Class 35, Applicant accepts the deletion of the Services in Class 39 in the alternative. T.B.M.P. § 1215.

Respectfully Submitted,

/SW/

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